

REMARKS

This Amendment is filed in response to the Office Action dated January 13, 2005. For the following reasons this application should be allowed and the case passed to issue. No new matter is introduced by this amendment. The amendment to claims 7 and 9 are supported by originally filed claim 1. The specification provides support for the amendment to claim 16 at page 21, line 16 to page 26, line 5.

Claims 7, 9-16, and 19-21 are pending in this application. Claims 1-6, 8, and 16-18 have been rejected. Claims 10-15 and 19-21 have been allowed. Claims 7 and 9 are objected to. Claim 16 has been amended and claims 1-6, 8, 17, and 18 have been canceled in this response.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, and 8 were rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Knieling et al. (U.S. Pub. Pat. App. No. 2002/0069672 A1). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

Claims 1, 2, and 8 have been canceled. Therefore, this rejection is moot.

Claim Rejections Under 35 U.S.C. § 103

Claims 3, 6, 16, and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Knieling et al. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

Claims 3, 6, and 17 have been canceled. Therefore, this rejection is moot as to claims 3, 6, and 17.

As regards claim 16, the following is a comparison between the invention as claimed and the cited prior art. An apparatus for manufacturing a glass tube comprises a heating element disposed to surround a glass material. A piercing plug operable to be pressed into a softened region of the glass material affects formation of the glass material into the glass tube. A first gas supply portion supplies a gas to an exterior of the glass tube. A first gas discharge portion discharges a gas from the exterior of the glass tube. A second gas supply portion supplies a gas to an interior of the glass tube. A second gas discharge portion discharges a gas from the interior of the glass tube. The second gas supply portions and the first and second discharge portions are operable to control flow rate of the gas so that an internal or external pressure of the glass tube is controlled.

The Examiner acknowledged that Knieling et al. did not expressly teach control of the pressure deviation between internal and external pressures such that the deviation was kept substantially constant. However, the Examiner concluded that the presence of a blow pipe would have required pressurization means. Therefore, it would have been obvious to include a means of maintaining a constant pressure because the inherent pressurizing means for the blow pipe would have been expected to run at a constant speed in the absence of some teaching to the contrary.

Although Knieling et al. disclose a blowpipe 28, Knieling et al., do not suggest the claimed apparatus. Knieling et al. do not disclose how the blow pipe 28 is used. In particular, there is no disclosure that gas is supplied or discharged via the blow pipe 28. Further, Knieling et al. do not disclose a gas supply portion for supplying a gas to the exterior of the glass tube and a gas discharge portion for discharging gas from the exterior of the glass tube, as required by claim 16. Furthermore, Knieling et al. require second gas supply and discharge passages for

supplying and discharging gas to and from the interior of the glass tube. Knieling et al. do not suggest an apparatus for manufacturing a glass tube comprising the first and second gas supply and discharge portions, as required by claim 16.

Claim 16 is not suggested by Knieling et al. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no suggestion in Knieling et al. to provide an apparatus for manufacturing a glass tube comprising first and second gas supply and discharge passages, as required by claim 16.

The only teaching of an apparatus for manufacturing a glass tube comprising a first gas supply portion for supplying a gas to N exterior of the glass tube, a first gas discharge portion for discharging a gas from the exterior of the glass tube, a second gas supply portion for supplying a gas to an interior of the glass tube, and a second gas discharge portion for discharging a gas from the interior of the glass tube wherein the first and second gas supply portions and the first and second discharge portions are operable to control flow rate of the gas so that an internal or external pressure of the glass tube is controlled, is found in Applicants' disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner's conclusion of obviousness is not supported by any factual evidence. The Examiner's retrospective assessment of the claimed

invention and use of unsupported conclusory statements are not legally sufficient to generate a case of *prima facie* obviousness. The motivation for modifying the prior art must come from the prior art and must be based on facts.

Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over Knieling et al. in view of Yokokawa et al. (U.S. Patent No. 5,785,729). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

Claim 5 has been canceled. Therefore, this rejection is moot.

Claims 4 and 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over Knieling et al. in view of Yokokawa et al. and further in view of Shigesane (JP 63-40735). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

Claims 4 and 18 have been canceled. Therefore, this rejection is moot.

Allowable Subject Matter

Claims 10-15 and 19-21 are allowed.

Claims 7 and 9 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. Claims 7 and 9 have been rewritten in independent form in accordance with the Examiner's recommendation and, therefore, should be allowed.

In light of the above Amendment and Remarks, this application should be allowed and the case passed to issue. If there are any questions regarding these remarks or the application in general, a telephone call to the undersigned would be appreciated to expedite prosecution of the application.

Application No.: 10/796,052

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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